



1615/14
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

John S. BOBO et al.

Group Art Unit: 1615

Application No.: 10/024,143

Examiner: J. Venkat

Filed: December 21, 2001

Docket No.: 108774

For: BIOCOMPATIBLE POLYMERS AND ADHESIVES: COMPOSITIONS, METHODS OF MAKING AND USES RELATED THERETO

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 15, 2004 Restriction and Election of Species Requirement, Applicants provisionally elect Group II, claims 1-2(part), 3(part), 8(part), and 9-12 and 23(part), drawn to a composition comprising a chemical moiety wherein R'X is a payload that is a therapeutic agent, with traverse.

I. The Restriction Requirement Should Be Withdrawn

The claims of at least Groups VI, X and XIV should be rejoined to, and examined with, the claims of Group II. All of the claims of Groups VI, X and XIV are directed to polymers comprising a composition as claimed in the claims of Group II. That is, the claims of Groups VI, X and XIV are directed to polymers comprising a composition comprising a chemical moiety wherein R'X is a payload that is a therapeutic agent. Accordingly, a search for the composition claimed in Group II would necessarily encompass polymers containing

such a composition, as claimed in Groups VI, X and XIV. According, the claims of Groups II, VI, X and XIV should be rejoined and examined together.

Furthermore, method claims 69-108, 109-148, and 149-151 include all of the limitations of claim 1 of elected Group II. MPEP §821.04 states that if the elected invention is directed to the product, and the claims to the product are subsequently found patentable, process claims that include all the limitations of the allowable product claims will be rejoined. Because method claims 69-151 include all of the limitations of elected product claim 1, method claim 69-151 must be rejoined and examined upon allowance of claim 1.

It is also respectfully submitted that the subject matter of all claims 1-151 is sufficiently related that a thorough search for the subject matter of any one Group of claims and species would encompass a search for the subject matter of the remaining claims and species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

II. The Election Of Species Requirement Should Be Withdrawn

In addition, Applicants provisionally elect the species of a therapeutic agent with traverse. At least claims 1, 2, 49, 69, 109 and 149 are generic to the elected species. Furthermore, at least claims 2, 3, 8, 9, 23, 25-29, 32, 33, 47, 48, 50, 53, 54, 68, 70-84, 88-94, 110-124, 128-134, 150 and 151 read on the elected species.

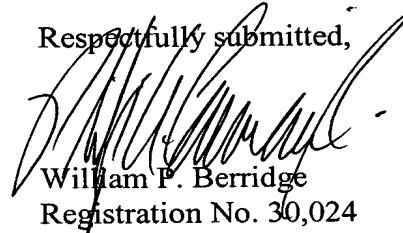
Applicants traverse the election of species requirement on the ground that the generic claims are not so broad as to place an undue burden on the Patent Office to search and examine

the full scope of the claims. Rather, Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,



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WPB:PAC/brc

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